REMARKS

It is noted that the claim amendments herein are intended solely to more particularly point out the present invention for the Examiner, and not for distinguishing over the prior art or the statutory requirements directed to patentability.

It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-20 are all of the claims pending in the present Application. Claims 1-19 and claims 13-19 stand rejected under 35 USC §112, second paragraph, as being indefinite and as being incomplete for omitting essential structure, respectively. Claims 1-6 stand rejected under 35 USC §101 as "... directed to method steps, which can be practiced mentally in conjunction with pen and paper, therefore they are directed to non-statutory subject matter."

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16, 17, and 19 stand rejected under 35 USC §103(a) as unpatentable over US Patent 6,370,560 to Costello, further in view of US Patent 6,105,053 to Kimmel et al. Claims 3, 9, and 15 stand rejected under 35 USC §103(a) as unpatentable over Costello, further in view of Kimmel, and further in view of US Patent 6,400,996 to Hoffberg et al. Claims 6, 12, and 18 stand rejected under 35 USC §103(a) as unpatentable over Costello, further in view of Kimmel, and further in view of US Patent Application Publication US 2001/0054094 A1 to Hirata et al.

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

As described and defined by, for example, independent claim 1, the present invention is directed to a computer-implemented method for determining a listing of hosts on a network to perform a parallel application, including determining a listing of all possible hosts on the network for performing the parallel application. For each of the possible host a current capacity and a current utilization is determined and a difference between the current capacity

and the current utilization is calculated. A listing of hosts is selected from the listing of all possible hosts, based on sorting the calculated differences.

II. THE 35 USC §112, SECOND PARAGRAPH, REJECTIONS

Claims 1-19 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite because the Examiner considers that the terminology "all possible hosts" in claims 1, 7, 13, 19 renders unclear whether this terminology refers to the host processors in line 1 of the claim. Although Applicants disagree with the Examiner's position, it is believed that the above claim amendments to claims 1 and 7 appropriately address the Examiner's concern. It is noted that claims 13 and 19 do not have the same terminology as claims 1 and 7 and are not, therefore, amended in the same manner.

Relative to the rejection for claims 13 and 19, Applicants again disagree that one of ordinary skill in the art would agree with the Examiner's position but, in an attempt to expedite prosecution, have amended these claims to address the Examiner's concern.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw these rejections.

III. THE 35 USC §101 REJECTION

The Examiner rejects claims 1-6 as allegedly directed to non-statutory subject matter because they "... can be practiced mentally in conjunction with pen and paper...."

Applicants respectfully traverse this rejection, since the criterion for rejection under 35 USC § 101 is <u>not</u> whether one might be able to practice the method mentally in conjunction with pen and paper. As the Federal Circuit has already stated, Federal Circuit judges are <u>not</u> going to proceed forward on patent infringement cases in which the alleged infringer is one performing a mental exercise. It is submitted that part of the problem is that the English language does not yet contain words that indicate the difference between verb actions done by a computer versus actions done by humans.

However, in an attempt to expedite prosecution, Applicants have amended claim 1 to indicate that the method is oriented towards a computer, in accordance with Examiner Tang's helpful suggestion.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

IV. THE PRIOR ART REJECTIONS

The Examiner alleges that Robertazzi, when modified by Kimmel, renders obvious the invention defined by claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16, 17, and 19. The Examiner further alleges that Robertazzi/Kimmel, when further modified by Hoffberg, renders obvious claims 3, 9, and 15, and, when further modified by Hirata, renders obvious claims 6, 12, and 18.

Applicants respectfully disagree.

First, it is submitted that the Examiner's prior art evaluation is constrained by the plain meaning of the claim language as understood by one of ordinary skill in the art. Therefore, in order to teach or suggest the method of the independent claims, the primary reference Robertazzi must teach, or at least suggest, the determination of the current capacity and current utilization of each host and calculate the difference between the two.

Applicants respectfully submit that one of ordinary skill in the art would consider that the method in Robertazzi is entirely different.

That is, as clearly described in the Abstract, rather than calculating the difference between current capacity and current utilization, the method of Robertazzi is based on determining the minimum overall costs by assigning loads to distributed processor platforms based on the resource utilization costs. As further explained in, for example, lines 18-27 of column 4, this cost is based on either monetary cost or speed.

However, the resource utilization cost of Robertazzi does not in any way include the difference between current capacity and current utilization as being one of the factors in determinind the resource utilization costs.

The Examiner relies upon Kimmel for demonstrating listing of a hierarchical tree structure, upon Hoffberg for demonstrating parallel-processing in real-time, and upon Hirata for demonstrating normalizing. However, even if these secondary references were to be considered as properly combinable with Robertazzi, none of them overcomes the basic deficiency in the primary reference identified above.

Hence, turning to the clear language of the claims, in Robertazzi, there is no teaching or suggestion of: "... determining for each of said possible host a current capacity and a current utilization; calculating for each of said possible host a difference between said current capacity and said current utilization; and selecting from said listing of all possible hosts a listing of hosts based on sorting said calculated differences ", as required by the independent claims.

For this reason alone, the present invention is clearly patentable over Robertazzi.

Second, it is submitted that the rejection currently of record fails to provide a proper motivation to modify the primary reference Robertazzi. That is, each of the secondary references address problems different from that of Robertazzi, including even different computer architectures. It is submitted that a reasonable, objective prior art evaluation requires that a secondary reference be at least attempting to solve the same or reasonably related problem as that attempted by the primary reference before it can be reasonably asserted that one of ordinary skill in the art would consider it obvious to apply an element missing in the primary reference.

At best, Applicants submit that the rejection of record merely identifies a reference that contains an element missing from Robertazzi and then attempts to simply insert this missing element into the primary reference, outside the context of its application in the secondary reference, and that the alleged motivation to modify the primary reference is that such modification would thereby achieve the benefit of having made the modification. Applicants submit that such circular reasoning would render everything obvious, since it is well known that most inventions are "merely" the result of a new combination of elements already known in the art.

However, as mentioned above, even if the secondary references were to be considered combinable with Robertazzi, the basic deficiency identified above for Robertazzi would not be

overcome. Applicants further submit that a modification to Robertazzi to remedy this deficiency would change the principle of operation of that reference.

Therefore, it is submitted that Robertazzi cannot even be used as the primary reference, since its basic principle of operation would have to be changed to accommodate the plain meaning of the independent claims. That is, it is noted that such change in principle would violate MPEP 2143.01: "*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims* prima facie *obvious*."

V. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0456.

Respectfully Submitted,

Date: 1/4/05

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